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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/663,135 | 09/16/2003 | Richard A. Cahill | CAHILL | 3998 |

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| EXAMINER |
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SHAIKH, MOHAMMAD Z

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| ART UNIT | PAPER NUMBER |
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3609

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| MAIL DATE | DELIVERY MODE |
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08/16/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------|------------------------------------|--|
| Office Action Summary | Application No. 10/663,135 | Applicant(s) CAHILL, RICHARD A. | |
| | Examiner Mohammad Z. Shaikh | Art Unit 3609 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1: ☐ Certified copies of the priority documents have been received.
- 2: ☐ Certified copies of the priority documents have been received in Application No. ____.
- 3: ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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Detailed Action

Claimed Objections

1. The unnumbered claim does not meet the requirements of rule 1.126 and has been renumbered. The claims should also start on a new sheet of paper.

Claim Rejections- 35 USC § 101

The following is a quotation of the appropriate paragraphs of 35 U.S.C 101 that forms the basis for the rejections made in this Office Action:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

2. The claimed invention is not supported by either an asserted utility or a well established utility. Applicant in paragraph (2) talks about the process may include the agreement of the heir/heirs as well as the individual or married couple who anticipates being their benefactors to said process.... they have legal recourse should the individual, partnership or business entity that they have contracted with to settle the estate in question fail to perform according to the terms of said agreement. Legal

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recourse is a fundamental right in our society. The right to sue is afforded to all citizens.

Applicant may not claim this right as his invention.

Claim Objections 35 U.S.C §112

The following is a quotation of the appropriate paragraphs of 35 U.S.C 112 2nd paragraph that forms the basis of this Office Action:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 1 is rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

The period at the end of the (a) on page of 1 of the claim makes it unclear if applicant intended to have two claims instead of one. On paragraph (2) on page 2, applicant states the process may include the agreement of the heir/heirs as well as the individual or married couple... This language is not definite, and needs to be changed.

Claimed Rejections- 35 USC § 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C 103 that forms the basis for the rejections made in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 1 is rejected under 35 U.S.C 103(a) as being unpatentable over US Patent number 6,430,542 to Moran (herein referred to as Moran) in view of US Patent number 5,864,685 to Hagan (herein referred to as Hagan).

Moran teaches a method of transferring assets from deceased persons to their beneficiaries, a pre-agreed settlement plan (col 3, lines 3-9). Moran also teaches any contract/contracts between any individual or married couple anticipating his/her/their demise and any individual, partnership or business entity capable of transferring and/or assisting in the transfer of said individual or married couple's estate after that demise, so that it becomes the legal property of said individual or married couple's heir or heirs, according to said individual or married couple's instructions (Abstract lines, 12-16). Moran teaches the married couples instructions for a fixed sum and according to fix schedule of costs along with a pre-agreed percentage of assets to reduce the cost of transferring their estate settlement plan (Col 38, lines 5-11).

Moran does not teach the process of including a requirement for individuals or married couples to own assets in a non-probatable fashion such as trusts or joint tenancy

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with their potential heirs. Hagan does teach this requirement for individuals or married couples to own assets in a non-probatable fashion such as trusts or joint tenancy with their potential heirs (Column 12, lines 40-44). It would have been obvious to one of ordinary skill in the art to modify the virtual executor of Moran to include the option of having trusts. Moran does not teach instructing a financial institution to maintain their accounts under a "pay on death" or "transfer on death" designation. Hagan does this requirement of instructing a financial institution to maintain their accounts under a "pay on death" or "transfer on death" designation (column 1, lines 41-42). It would have been obvious to one of ordinary skill in the art to modify Moran's invention to include a financial institution to pay on death or transfer on death.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad Z. Shaikh whose telephone number is (571)270-03444. The examiner can normally be reached on Monday-Friday (7:30-5); alt Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dixon can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mohammad Z Shaikh
Examiner
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THOMAS A. DIXON
SUPERVISORY PATENT EXAMINER